

REMARKS

The above amendments and following remarks are submitted under 37 C.F.R. 1.116 in response to the Final Official Action of the Examiner mailed April 27, 2005. Having addressed all objections and grounds of rejection, claims 1-25, being all the pending claims, are now deemed in condition for allowance. Entry of these amendments and reconsideration to that end is respectfully requested.

Claims 1, 6, 11-13, and 16 have been rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,615,212, issued to Dutta et al (hereinafter referred to as "Dutta"). This ground of rejection is respectfully traversed as to amended claims 1, 6, 11-13, and 16 for the reasons provided below.

In his remarks in paragraph 8 of the pending official action, the Examiner has kindly indicated certain issues concerning his anticipation rejection and Applicants' previous response. Applicants wish to thank the Examiner for providing this particularly helpful comments. In response thereto, Applicants have herewith amended all pending claims in accordance with the suggestions of the Examiner. On this basis alone, it is assumed that all pending claims are now allowable.

Claim 1 has been previously amended to more explicitly require the "two-step" conversion process of the present invention. A first conversion is made at the "adapter" and a second conversion

is made at the "middleware generic gateway". This feature is clearly not found in Dutta, because it has no need. All of the computers in the Dutta system communicate directly in TCP/IP.

Furthermore, claim 1, as amended, now requires creation of the "request parameter buffer". Again, this feature is not found in any of the prior art of record. Furthermore, though the Examiner has had opportunity to do so, he has not even allege that Dutta has this feature.

The rejection of claim 1, as amended, and all claims depending therefrom, is respectfully traversed for failure of Dutta to teach each and every element of the claimed invention as required by MPEP 2131.

The same issues arise with regard to the rejection of claim 6. Claim 6, as amended, requires a "request parameter buffer" which is not found in Dutta as explained above. Dutta says nothing of this claimed limitation. The rejection of claim 6, and all claims depending therefrom, is respectfully traversed.

In rejecting claim 16, the Examiner repeats these clearly erroneous findings of fact and compounds the problem by failing to conduct the examination in accordance with MPEP 2181, et seq. The rejection of claim 16, and all claims depending therefrom, is respectfully traversed.

Claim 11, as amended, is an independent method claim having four steps. As explained previously, Dutta has none of these three

steps prior to amendment. Newly presented step d requires "packing said converted service request into a request buffer compatible with a legacy data base management system by said generic gateway". This limitation is simply not found in Dutta. Applicants' position regarding the absence of the other steps in Dutta has been previously presented. The rejection of claim 11, and all claims depending therefrom, is respectfully traversed for failure of Dutta to teach all of the claimed elements as required by MPEP 2131.

Claim 12 depends from claim 11 and is further limited by an additional transferring step to transfer the processed service request in the form of the request input buffer from the generic gateway to the end service provider. Dutta has no "request input buffer". Therefore, Dutta cannot meet the limitations of claim 12. The rejection of claim 12, and claims depending therefrom, is respectfully traversed.

Claim 13 depends from claim 12 and adds further limitations. Because Dutta does not teach the limitations of the claims from which claim 13 depends, it cannot possible teach the unique combination including the additional limitations of claim 13. Therefore, the rejection of claim 13, and any claim depending therefrom, is respectfully traversed.

The Examiner has rejected claims 2-3, 5, 7-8, 10, and 17-25 under 35 U.S.C. 103(a) as being unpatentable over Dutta in view of U.S. Patent No. 5,848,415, issued to Guck et al (hereinafter

referred to as "Harvey"). This ground of rejection is respectfully traversed for the following reasons.

To present a *prima facie* case of obviousness, MPEP 2143 requires the Examiner to provide evidence of: 1) motivation to create the alleged combination; 2) reasonable likelihood of success of the alleged combination; and 3) all claimed elements within the alleged combination. The rejection is respectfully traversed, because the Examiner has not provided any such evidence and has therefore has not made a *prima facie* case of obviousness. Applicants have previously presented their position with regard to the failure of the Examiner to show "motivation" or "reasonable likelihood of success" as required by MPEP 2143. Though the Examiner has had opportunity to comment upon and/or clarify his position with regard to his burden to make these showings under MPEP 2143, he has chosen not to do so. Therefore, these issues are deemed preserved for future adjudication.

Finally, the alleged combination does not meet the requirement of MPEP 2143 that all claimed limitations are met. Specifically, claim 2 has been amended as suggested by the Examiner to include the location of the adapters. The rejection of claim 2, as amended, is respectfully traversed for failure of the Examiner to meet any of his three burdens of proof imposed by MPEP 2143.

Similarly, with regard to claim 7, the claim has been amended as recommended by the Examiner. The rejection of claim 7, as

amended, is respectfully traversed for failure of the Examiner to present a *prima facie* case of obviousness as required by MPEP 2143.

Claims 3 and 8 depend from claims 2 and 7, respectfully, and each presents additional claim limitations. The alleged combination does not teach the limitations of the claims from which claims 3 and 8 depend. Therefore, the alleged combination cannot possibly teach the limitations of claims 3 and 8. The rejection of claims 3 and 8 is respectfully traversed.

Claims 5 and 10 depend from claims 4 and 9, respectively. Therefore, claim 5 contains all of the limitations of claim 4, and claim 10 contains all of the limitations of claim 9. At paragraph 5 of the pending official action, the Examiner admits that the alleged combination of Dutta and Guck does not meet the limitations of claims 4 and 9. Therefore, the pending rejection of claims 5 and 10 is inadequate as a matter of law. Though this has been previously explained to the Examiner, he has neither acknowledged the readily apparent error of law nor cited any authority in support of his anomalous position. As a result, the finality of the pending official action is premature as a matter of law. The rejection of claims 5 and 10 is respectfully traversed for failure of the Examiner to properly apply controlling law.

In rejecting claims 17 and 18, the Examiner repeats all of the errors in his rejection of claims 2 and 7. The rejections of claims 17 and 18, as amended, are respectfully traversed.

Claim 19 depends from claim 18 and includes further limitations. Because the alleged combination cannot meet the limitations of claim 18, it cannot meet the limitations of claim 19. The rejection of claim 19, as amended, is respectfully traversed.

In rejecting claim 20, the Examiner admits that the prior art of record does not meet all of the limitations. However, the Examiner takes official notice stating:

....because doing so would allow a user to use a graphical interface to send and receive messages or requests and therefore have a more friendly user environment.

This argument is inadequate as a matter of law. Dutta already discloses the use of OS-2 with a graphical user interface. The Examiner has shown no motivation to make any modifications to Dutta. Though this error of law has been previously made of record, the Examiner has chosen to neither modify his rejection nor cite new authority for his current position. Therefore, the finality of the pending rejection is premature as a matter of law, and the rejection of claim 20 is respectfully traversed.

The Examiner readily admits that contrary to the requirements of MPEP 2143, the alleged combination does not have all of the limitations of claim 21. Instead, he takes "official notice" of certain missing limitations. This finding has been properly

traversed under MPEP 2144. As a result, the Examiner is obligated, as a matter of law, to present a reference providing these limitations. Apparently, the Examiner has relied upon an alleged document not properly of record in this proceeding. Therefore, the Examiner has not complied with his burden under MPEP 2144. The rejection of claim 21 is respectfully traversed as improperly examined without compliance with controlling law.

Claim 22 depends from claim 21 and is further limited by a "view definition which describes a format for said XML message service request". The alleged combination does not have these limitations. Therefore, the Examiner cites Guck, column 2, line 58, through column 3, line 20, knowing that the citations says nothing about the claim limitation. The rejection of claim 22 is respectfully traversed.

Claim 23 depends from claim 22 and is further limited "wherein said generic gateway converts said XML message service request into a data buffer in accordance with said input view definition". Again, the Examiner confusingly mentions the same Guck citation which has nothing to do with this limitation. The rejection of claim 23 is respectfully traversed.

The Examiner repeats the same errors with regard to his rejection of claim 24. Guck simply says nothing of the limitations of claim 24. The rejection of claim 24 is respectfully traversed.

Claim 25 depends from claim 24 and further requires an output buffer. Guck makes no mention of this structure. The rejection of claim 25 is respectfully traversed.

Claims 4 and 9 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Dutta in view of Guck and further in view of U.S. Patent No. 6,397,220, issued to Deisinger et al (hereinafter referred to as "Deisinger"). This ground of rejection is respectfully traversed for failure to present a *prima facie* case of obviousness.

In rejecting claims 4 and 9, the Examiner states:

It would have been obvious for (sic) one of the (sic) ordinary skill in the art at the time of the invention to modify Dutta by implementing an NT server in a WebTx environment as taught by Deisinger because doing so would transform a request such as a URL from A Web browser into a format which is understandable by a distributed transaction processing system and also transform data returned from the distributed transaction processing system into a formatted response which is returned to the requester and therefore overcoming compatibility issues with a client and a server.

This is precisely the unsupported conclusion attacked by the Court of Appeals for the Federal Circuit stating in part:

Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence". *In re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q. 2d 1614 (Fed. Cir. 1999).

Thus, in contravention of controlling law, the Examiner concludes that the alleged combination is motivated because it is alleged to provide completely unrelated functionality to the alleged

combination of Dutta and Guck. As explained by the Federal Circuit, this is insufficient as a matter of law.

Again, the Examiner fails to provide the required evidence of reasonable likelihood of success.

Finally, the Examiner does not show how the alleged combination would meet the limitations of the claims. He cannot say where within the alleged combination of Dutta and Guck, the NT server having WebTx middleware would be added. The alleged combination seems to make no sense. Therefore, the rejection of claims 4 and 9 is respectfully traversed for failure of the Examiner to meet his obligations under MPEP 2143 to present a *prima facie* case of obviousness.

Claim 14 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Dutta in view of U.S. Patent No. 6,438,580, issued to Mears et al (hereinafter referred to as "Mears"). This ground of rejection is respectfully traversed for failure of the Examiner to meet his burden under MPEP 2143 for the establishment of a *prima facie* case of obviousness.

Claim 14 depends from claim 13 (which depends from claims 12 and 11) and is further limited by "wherein said one of said plurality of formats further comprises an active server page". Any fair reading of claim 14 acknowledges that the limitations of claim 14 further limit the claim 11 limitation of "a plurality of adapters corresponding to said one of said plurality of formats".

In other words, claim 14 requires that the system employ an adapter that corresponds to "an active server page". The Examiner directly admits that this limitation is not found in Dutta. Furthermore, the Examiner indirectly admits that it is not found in Mears but instead cites column 5, lines 45-59, which mentions active server pages but says nothing of the claimed "adapter". The alleged combination does not teach the claimed elements.

Again, the Examiner does not even attempt to meet his obligation to show reasonable likelihood of success. Finally, in his attempt to conclude motivation, the Examiner states:

It would have been obvious for one of the (sic) ordinary skill in the art at the time of the invention to modify Dutta by using active page server (sic) format as taught by Mears because doing so would allow the user (sic) view a message using an HTML page using a web browser and therefore overcome the need of an e-mail software (sic).

Though this conclusion is not completely understood, it does seem clear that it has nothing to do with the claimed invention which requires an adapter corresponding to active server page format.

The rejection of claim 14 is respectfully traversed for failure to present a *prima facie* case of obviousness as defined by MPEP 2143.

Claim 15 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Dutta in view of U.S. Patent No. 6,442,559, issued to Krishan et al (hereinafter referred to as "Krishan"). This ground of rejection is respectfully traversed for failure of the Examiner to present a *prima facie* case of obviousness.

Claim 15 depends from claim 14 and further limits one of the plurality of adapters (see claim 11). Claim 15 depends from and includes all of the limitations of claims 14, 13, 12, and 11. As admitted by the Examiner:

Dutta does not explicitly teach the claimed limitation "said plurality of formats further comprises an active server page".

Therefore, the Examiner specifically admits that the alleged combination of Dutta and Krishan does not meet the limitations of claim 15. The rejection of claim 15 is respectfully traversed as a matter of law.

Having thus responded to each objection and ground of rejection, Applicants respectfully request entry of this amendment and allowance of claims 1-25, being the only pending claims.

Please charge any deficiencies or credit any overpayment to

Deposit Account No. 14-0620.

Respectfully submitted,

Daniel P. Starkovich et al.

By their attorney,

Date June 27, 2005


Wayne A. Sivertson

Reg. No. 25,645

Suite 401

Broadway Place East

3433 Broadway Street N.E.

Minneapolis, Minnesota

55413

(612) 331-1464